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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,013	07/25/2003	Daniel Dietzel	3401-138	3993
7590 04/30/2008				
Thomas C. Pontani, Esq. Cohen, Pontani, Lieberman & Pavane Suite 1210 551 Fifth Avenue New York, NY 10176				
EXAMINER				
ARAJ, MICHAEL J				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
04/30/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/628,013

**Applicant(s)**

DIETZEL ET AL.

**Examiner**

MICHAEL J. ARAJ

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12, 17-21, 25-28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12, 17-21, 25-28 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

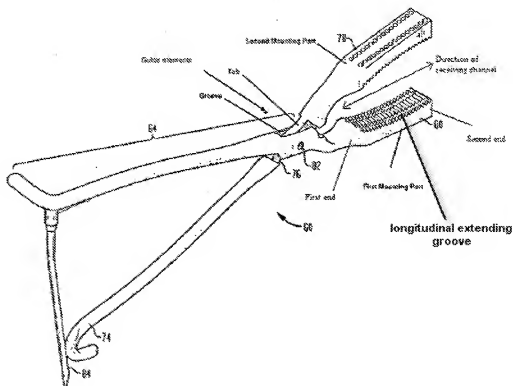
Claims 12, 17-21, 25-28 and 30 are rejected, as understood, under 35 U.S.C. 102(e) as being anticipated by Abdelgany et al. (U.S. Publication No. 2002/0082604).

Abdelgany et al. disclose a device that includes a first mounting part, having first side with first and second opposing ends, defining a receiving channel extending along an entire length of said first mounting part having a longitudinally extending groove and that has a longitudinal axis along the length between said first and second ends of said first side (see Figure 1 below). The mounting part further defines at least one slot (See Fig. 7C) therethrough at an angle oblique to the longitudinal axis of the receiving channel. The first mounting part defines two intersecting slots in the region of the receiving channel each having an acute but different angles relative to the longitudinal axis of the receiving channel, where the second mounting part receivable on the first mounting part has at least one slot arranged. It can also be seen that the first and second slots fall within the range of being between 4 and 13 degrees. The second

mounting part also defines a receiving channel where the first and second mounting parts face each other when second mounting part is received on first mounting part (see Figure 1 below) and are receivable on each other. There are also grooves in the receiving channel can also be seen as being V-shaped which also gives rise to that surface being roughened. Abdelgany et al. also discloses that each first and second mounting parts include guide elements positioning the parts relative to each other such that the slots and receiving channels face each other and are arranged congruently. These guide elements can be considered normal to the longitudinal axis of the receiving channel if the longitudinal axis of the receiving channel is defined as perpendicular to the entire length of the device. Also in looking at the slots in Fig. 7C it can be seen that these slots are configured so that an extent of each of said first and second slots in a direction of the longitudinal axis of the channel is greater than an extend of the each of the first and second slots in a direction transverse to the longitudinal axis of the channel. With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Abdelgany et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not

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differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).



**Figure 1**

***Response to Arguments***

Applicant's arguments filed February 8, 2008 have been fully considered but they are not persuasive. Applicant argues that the receiving channel is not defined by a groove. Figure 1 above clearly defines the receiving channel.

In response to Applicant's argument that Abdelgany structurally different, the fact that Applicant uses the cutting block for a different purpose does not alter the conclusion that its use in a prior art device would be prima facie obvious from the

purpose disclosed in the reference. Also, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The only requirement is that the claims read on the prior art.

Applicant argues that Abdelgany fails to disclose, teach or suggest a groove with a V-shaped cross-section. If one were to take a cross-section of the receiving channel in the same direction as the direction of the receiving channel, the side profile of this cross-section would show the teeth of the device which are v-shaped. Therefore Abdelgany fulfills this requirement of having a v-shaped cross-section.

Applicant argues that Abdelgany does not have a first and second mouthing part including guide elements. The guide elements (handles) do not have to be considered as a remote part to the mounting parts. The guide elements are considered to be the portion of the "handle" that is in contact with the first end of the mounting part as shown in Figure 1 above.

Lastly, applicant argues that Abdelgany is not sized and dimensioned to receive "a bone cylinder of a predetermined thickness and length obtained using a punch sleeve" because Abdelgany states that the device receives a donor bone. Even though Abdelgany does not specifically state this in the specification, one could perform this function if one so desired. This statement is functional and is not required to actually state this occurrence but only to be able to perform such a function.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. ARAJ whose telephone number is (571)272-5963. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael J Araj/  
Examiner, Art Unit 3733

/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733



**Application Number****Application/Control No.**

10/628,013

**Applicant(s)/Patent under  
Reexamination**

DIETZEL ET AL.

**Examiner**

MICHAEL J. ARAJ

**Art Unit**

3733